

REMARKS

Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the amendments and following remarks. Claims 1-19 remain pending herein and stand rejected. Claims 1 and 10 are the only independent claims.

Claims 1, 2, 9-11, 18 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard et al. (USPPA 2004/0259630) in view of Smith (US Pat. No. 6,580,914), and further in view of Meade (US Pat. No. 7,206,559). Claims 3-8 and 12-17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard in view of Smith and Meade, and further in view of O'Neil (US 2002/0107027).

Applicant respectfully disagrees with, and explicitly traverses, the Examiner's reason for rejecting the claims. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim, as amended and with emphasis added, recites:

1. A method for providing user data pertaining to a user of a mobile terminal to a recommender system of a consumer electronic device, the method comprising the steps of:

determining, by the terminal, a current location of the terminal, wherein said current location is determined after receiving a initiating signal, said initiating signal being one of a user input and a received signal;

saving, in the terminal, an identifier of the determined location, based on a longevity of said terminal in an area proximate said current location; and

informing, **by means of the terminal**, said recommender system of the determined location;

wherein said determining step comprises determining a length of time for which the terminal stays in a region, and said recommender system is arranged for proposing **content related to said region** if the length of time is longer than a predetermined time period.

The Office Action relies on Huard as the primary reference against the claimed invention. Huard relates to a method and system for rewarding a user's interest in an activity. In particular, Huard relates to a central location by which various inputs are received and processed to reward prizes to various users based on their (gambling) activities (see for example, paragraph [0023]).

However, as emphasized above, in claim 1 the terminal is used to inform the recommender system of the determined location. Huard teaches away from this feature as his input to the recommender system relies on an activity monitor as described, *inter alia*, in paragraphs [0020 - 0021]:

An activity monitor, **communicating with the locator** [emphasis added] and the timer, is provided for monitoring an interest of the user in the activity for

the period of time, at the location. The activity monitor receives an indication of the period of time from the timer and receives a signal from the locator that a player is located at a particular location, such as a player position at a casino table. During the period of time, the [activity] monitor verifies [emphasis and comment added] if the same player is located at the location and maintain his interests in the activity. If the required activity is betting in a casino table game, the monitor receives an indication from the locators and/or from the dealer/employee console as to whether the player is continuously betting or if he has stopped. Depending on the conditions chosen for the monitoring, a player who stops betting in the casino table game but remains at his original location may be eligible to the reward or his participation may be rejected.

If at least one user has maintained an interest for the period of time, at his own location, a selector [“Recommender”] decides if a prize should be awarded to the user ...

Thus as noted above, it is the activity of the activity monitor that communicates with the recommender. Moreover, as indicated above, this activity monitor is a separate entity than that of the terminal itself.

Consequently, while the Office Action does combine the teachings of Huard with those of Smith to address activities being done at the mobile terminal, neither reference teaches informing the recommender system by the mobile terminal itself, as required by the claim language. For at least this reason alone, the §103 rejection of claim 1 in the Office Action fails as Huard teaches away from this feature.

Further, the Office Action uses Meade in combination with Huard and Smith to teach a mobile device “being used to apply and update user preferences in appliance and consumer devices” (Office Action, Page 4 second full paragraph). Meade discloses a system for controlling an appliance by a mobile computing device by determining an available content for the appliance, selecting the content used by the appliance and applying user preferences to the appliance. The Office Action points to col. 8, lines 51-54 of Meade as somehow, in combination with Huard and Smith, teaching the claim element “informing, by means of the terminal, said recommender system of a consumer electronic device of the determined location.” This section of Meade merely describes Fig. 4 wherein program recorder 110 has TIVO capability and VCR capability. There is nothing in Meade (nor in Huard or Smith) which relates to a recommender system of a consumer electronic device which uses locations determined and recorded by a mobile terminal, that are then provided and used by an electronic device’s recommender system “for proposing **content related to said region** [emphasis added] if the length of time is longer than a predetermined time period” (claim 1, last 3 lines).

As bolded above, the present invention as defined by amended claim 1, relates to a recommender system that proposes content related to a past location when the user’s terminal has remained in that location for a period of time in excess of a predetermined time. While a TIVO does provide recommendations, these are typically based on a user’s past viewing history. As of the January 13, 2004 priority date of this application, Applicant submits that TIVO devices did not provide recommendations related to past locations visited by a user, in the manner recited in claim 1. Accordingly, even if the

combination of Huard, Smith and Meade was proper, this combination fails to address the features of claim 1 in that the recommendation provided relates to a region in which the terminal remained in excess of a predetermined period of time. In particular, Applicant submits that such capability does not exist in Meade's teaching of the use of a TIVO device as recited in the Office Action.

Applicant respectfully submits that the combination of Huard, Smith and Meade fail to teach the features of claim 1, to include a consumer device's recommender system being informed by a mobile terminal of data pertaining to the device's location and duration at that location, the data having being determined and saved by the mobile terminal; and the recommender system proposing content related to said region if the length of time is longer than a predetermined time period.

Accordingly, applicant submits that the combination of Huard, Smith and Meade fails to teach the elements of claim 1, contrary to the assertions of the Office Action. Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Applicant submits that the reasons for the Examiner's rejections of claim 1 has been overcome and can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claim 1. Independent claim 10 recites features similar to those of claim 1 and is deemed patentable for at least the same reasons.

Further, Applicant submits that the combination of Huard, Smith and Meade cannot sustain a §103 obviousness rejection as there is no motivation to combine these teachings. In order to establish a prima facie case of obviousness, generally three basic criteria must be met:

1. there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The **teaching or suggestion** to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck* (citation omitted).(emphasis added).

However, in addressing obviousness determination under 35 USC §103, the Supreme Court in *KSR International v. Teleflex Inc.* (citation omitted) reaffirmed that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." (citation omitted). The Court stated that "it can be important to identify a reason that would have prompted a person ...to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known. (citation omitted). The Court further addressed the standard for obviousness that had been imposed in decisions rendered by the CAFC in that there must be some teaching, suggestion or motivation (TSM) to combine the known elements in the same manner set forth in the claims and found that the TSM to combine provides a

"helpful hint" in determining whether claimed subject matter is obvious. The Court however stated that the application of the TSM test is not to be applied in a rigid manner. Rather, the Court favored a more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements. Hence, the Court upheld precedent that "when prior art references require a selected combination to render obvious, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making the combination." Uniroyal Inc. v. Rudkin-Wiley Corp., (citation omitted).

Meade discloses a system for controlling an appliance by a mobile computing device by determining an available content for the appliance, selecting the content used by the appliance and applying user preferences to the appliance. The user preferences of Meade as they relate to appliances are discussed in col. 18, lines 45 – 58 [emphasis added]:

Appliance preferences 406 determines the preferences a user has for appliances 13 they will control. Appliance preferences 406 optionally include a set of preferences for when no other mobile computing devices 12 are present (i.e., the user is alone) and a different set of preferences for when other mobile computing devices 12 are present (i.e., other users are present). However, when user interface 90 is employed by appliance 13, then appliance 13 can set some preferences that will influence control of that appliance 13 by mobile computing device 12. **Appliance preferences 406 includes** auto activation function 460, **media selection** 462 with default **program and station list** 464, **volume** 466, **lighting level** 468, and interactions and transfers function 470. Auto-activation

function 460 determines whether appliance 13 will be automatically activated in the presence of mobile computing device 12. In concert with appliance content selector 92, media selection 462 determines default content selections for appliance 13. Volume 466 and lighting level 468 determine, respectively, a desired audio volume level for content performed on mobile computing device 12 and a light level of appliance 13 when appliance 13 is so equipped. For example, volume component 466 of appliance preferences 406 optionally includes a preference to automatically increase the volume of an appliance when the user is alone (i.e. no other mobile computing devices 12 are present).

Mead thus relates to controlling appliances by a remote device. Huard relates to providing prizes to gamblers based on their monitored activities. Huard discloses that one aspect of such monitoring, location determination, may be performed by a remote device. Huard's invention requires a separate activity monitor to provide the necessary functionality. Such a remote device of limited functionality, even in combination with Smith, is clearly distinguishable from the device of Meade. Moreover, what "user preferences" are being provided by Huard's terminal? What aspect of Huard relates to an appliance and its preferences as taught by Meade? In short, why would anyone think to combine the different devices of Huard and Mead, other than to follow the blueprint of the claimed invention?

In addressing the obviousness rejection under 35 USC §103, the *KSR* Court did not diminish the requirement of objective evidence of obviousness. Rejections on the grounds of obviousness cannot be sustained by mere conclusory statements as there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness.

In this case, the Examiner has selected elements from different prior art references to find elements recited in the claims. However, other than the conclusory statement that it would be obvious to incorporate the teachings of Meade and Smith into the teaching of Huard, the Office has failed to provide any objective teaching or motivation to modify the Huard reference to properly address the claim features.

Accordingly, with regard to the subject matter recited in claims 1 and 10, Applicant respectfully submits that pursuant to an expansive interpretation of the three basic criteria necessary to show obviousness, a *prima facie* case of obviousness has not been set forth because the combination of the cited references has been impermissibly selected using the teachings of the instant application as a blueprint without any suggestion or reason for such combination.

In this case, Applicant believes that with regard to the referred-to claims, the Examiner has impermissibly incorporated the teachings of the present invention in the cited reference to reject the claims. Accordingly, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claim 1 is allowable, and the rejection should be withdrawn. Independent claim 10 recites similar features and is deemed patentable for at least the same reasons.

Claims 2-9 and 11-19 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

Applicant denies any statement, position or averment stated in the Office Action that is not specifically addressed by the foregoing. Any rejection and/or points of argument not addressed are moot in view of the presented arguments and no arguments are waived and none of the statements and/or assertions made in the Office Action is conceded.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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